

REMARKS

Status Of Application

Claims 1-15 are pending in the application. The status of the claims is as follows:

Claims 1-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,673,373 to Nosaki et al (hereinafter the "Nosaki patent"); and

Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the Nosaki patent and further in view of Japanese Publication No. 06070079 (A) to Karaki Masato (hereinafter the "Masato publication").

Information Disclosure Statement

To date, Applicant has not received an initialed copy of the Information Disclosure Statement, which was submitted on 7/1/98. Applicant respectfully requests a copy of this document.

35 U.S.C. § 103(a) Rejections

The rejection of claims 1-14 under 35 U.S.C. § 103(a), as being unpatentable over the Nosaki patent, is respectfully traversed based on the following.

Claim 1-10

The present invention according to claim 1 requires a facsimile apparatus which has a memory for storing received confidential image data, a notification data transmission means for transmitting notification, to an origin, that the received image data has not be retrieved from the memory, and a deletion means for deleting the confidential image data from the memory in response to a completion of transmission of the notification by the notification data transmission means, wherein the notification is transmitted if the received confidential image data has not been retrieved from the memory within a predetermined period of time.

Thus, according to claim 1, confidential image data received and stored in the memory of the facsimile is deleted after a sender is properly informed that the data that was sent has not been retrieved from the facsimile apparatus within a predetermined period of time. Accordingly, the memory capacity of the facsimile apparatus is not restricted by received confidential image data that remains in the memory for a prolonged period of time without being retrieved.

The Nosaki patent is directed to an image forming system that allows a user to perform a secret print operation. A user of the Nosaki device is able to input a secret print command from a terminal, and subsequently receive a password which is assigned by a printer that will print the print job. The user can then approach the specific printer that will perform the print operation, and enter the password and receive the corresponding print job.

Although the Nosaki patent does disclose a device that relays a secret print job password to a user, the Nosaki patent does not disclose or suggest a facsimile apparatus having a notification data transmission means for transmitting notification, to an origin, that received confidential image data has not been retrieved from the memory of the facsimile apparatus. In fact, although the Nosaki patent discloses a device that is capable of informing a user of error information if a rasterization operation is not completed and informing a file server of an end of print job specific data, the Nosaki patent fails to disclose or offer any teachings which suggest transmitting notification, to an origin, that received confidential image data has not been retrieved from memory.

The Nosaki patent also does not disclose or suggest a deletion means for deleting the confidential image data from the memory in response to completion of transmission of the notification by the notification data transmission means, and similarly, the Nosaki patent does not disclose or suggest that the notification is transmitted if the received confidential image data has not been retrieved from the memory within a predetermined period of time.

Claims 2-10 depend either directly or ultimately from claim 1. Therefore, claims 2-10 are not rendered obvious by the Nosaki patent.

Claim 2 is further distinguished from the Nosaki patent. In particular, although the Nosaki patent does disclose a password notification or an error notification can be sent to a user terminal, the Nosaki patent does not disclose or suggest that the notification, transmitted to the origin, includes at least part of the confidential image data. Thus, claim 2 is distinguished over the Nosaki patent.

With respect to claim 6, the Nosaki patent does not disclose or suggest a notification data transmission means that re-transmits notification when transmission of the notification is not completed successfully. The Office Action states that it is obvious to a person of ordinary skill to redial/re-transmit to a source, however, the Nosaki patent does not suggest or provide any motivation to re-transmit notification when transmission of the notification is not completed successfully. Thus, it is unclear what occurs when, for example, several attempts for transmission are made and still transmission does not occur successfully. Therefore, despite the statements in the Office Action, claim 6 is not rendered obvious by the Nosaki patent.

Claim 7 further requires a prohibiting means for prohibiting the deletion of confidential image data when transmission of notification is not completed within a predetermined number of transmission attempts. Thus, claim 7 further clarifies what occurs when a predetermined number of unsuccessful attempts to transmit notification occurs. More specifically, in the invention according to claim 7, the confidential image data is not deleted because the origin has not been properly informed. The Nosaki patent neither discloses nor suggests a device that prohibits deletion of confidential image data when a predetermined number of transmission attempts of notification have been unsuccessful. Therefore, claim 7 is distinguished from the Nosaki patent.

Claims 11 and 12

Claim 11 recites,

A facsimile apparatus provided with a confidential reception function, comprising:

- a memory which stores received confidential image data;
- an output means for outputting stored confidential image data from said memory in response to input of a password by an operator;
- a determination means for determining whether confidential image data has been outputted by the output means within a predetermined time after reception of the confidential image data;
- a notification data transmission means for transmitting notification, that confidential image data has not been outputted from the memory, when the determination means has determined that outputting of the confidential image data from the memory has not been performed;
- a detection means for detecting proper completion of transmission of the notification; and
- a deletion means for deleting confidential image data from the memory in response to detection of proper completion of transmission of the notification by the detection means.

As the above argument of claim 1 over the Nosaki patent showed, the Nosaki patent does not disclose or suggest a notification data transmission means for transmitting notification, that confidential image data has not been outputted from the memory, when a determination means has determined that outputting of the confidential image data from the memory has not been performed.

The Nosaki patent also does not disclose a detection means for detecting proper completion of transmission of notification. The Office Action cites column 7, lines 64-67, and Fig. 11, of the Nosaki patent in the rejection of the detection means of claim 11. Both of these cited portions of the Nosaki patent will be discussed below.

Fig. 11 of the Nosaki patent discloses that deletion of data occurs. However, there is nothing in Fig. 11 to indicate or suggest that deletion occurs in response to a completion of transmission of notification. In fact, according to Fig. 11 of the Nosaki patent, deletion occurs without verification of completion of a transmission of information to the user.

Column 7, lines 64-67, of the Nosaki patent is a portion of the description of a common print operation, i.e., a non-secret print job, as stated at column 7, lines 46-47. The statement, at column 7, line 64, of the Nosaki patent, that "it is checked whether all data were sent and if all data were sent, the file is deleted" is in reference to data being transferred from a file to a designated printer in a non-secret print mode, as can be seen in Fig. 9 of the Nosaki patent. Therefore, column 7, lines 64-67, of the Nosaki patent refers to transferring image data from file server 3 (column 7, lines 36-38) to a designated printer in a ordinary mode and does not disclose or suggest detecting proper completion of transmission of notification that confidential image data has not been outputted from memory.

It also follows that the Nosaki patent does not disclose or suggest a deletion means for deleting confidential image data from the memory in response to detection of proper completion of transmission of the notification by the detection means. Specifically, the Nosaki patent does not disclose or suggest a detection device which detects proper completion of transmission of notification. Thus, the Nosaki patent could not disclose or suggest a deletion means for deleting confidential image data in response to detection of proper transmission of notification by the detection means.

Therefore, as the Nosaki patent does not disclose or suggest all of the features of claim 11, claim 11 could not be rendered obvious by the Nosaki patent. Claim 12 depends from claim 11; therefore, claim 12 is also not rendered obvious by the Nosaki patent.

Further, the requirements of claim 12 are not disclosed or suggested by the Nosaki patent. More specifically, the Nosaki patent fails to disclose or suggest a device which transmits notification that confidential image data has not been outputted from memory, wherein the notification includes at least part of the confidential image data. Thus, claim 12 is distinguished over the Nosaki patent.

Claims 13 and 14

Claim 13 requires a method including the steps of transmitting notification, that output has not occurred, when outputting of the confidential image data has not occurred within a predetermined time, detecting proper completion of transmission of the notification, and deleting the confidential image data from the memory in response to a detection of the proper completion of transmission of the notification. The Nosaki patent neither discloses nor suggests these features of claim 13.

The Office Action cites column 12, lines 51-58, and column 8, lines 22-31, of the Nosaki patent, in the rejection of claim 13 as reciting a method which teaches transmitting notification, that output has not occurred, when outputting of the confidential image data has not occurred within the predetermined time. However, none of these cited portions of the Nosaki patent teaches transmitting notification as required by claim 11. Column 12, lines 51-58, of the Nosaki patent, discloses that file server 3, of the Nosaki device, retains a comparison table which contains a user name corresponding to a User specific data, whereas column 8, lines 22-31, of the Nosaki patent discloses data transfer operations between file server 3, print server 2, and terminal 1. Neither of these cited portions of the Nosaki patent discloses or suggests transmitting notification, that output has not occurred, when outputting of confidential image data has not occurred within a predetermined period.

Similarly, the Nosaki patent does not disclose or suggest detecting proper transmission of notification that output has not occurred when outputting of confidential image data has not occurred within a predetermined time, and also does not disclose or suggest deleting the confidential image data from the memory in response to a detection of the proper completion of transmission of the notification. Therefore, claim 13 is not rendered obvious by the Nosaki patent.

Claim 14 depends from claim 13 and is distinguished over the Nosaki patent.

Further, regarding claim 14, the Nosaki patent does not disclose or suggest a method wherein notification that output has not occurred includes at least part of the

confidential image data. Thus, claim 14 is further distinguished from the Nosaki patent.

Accordingly, it is respectfully requested that the rejection of claims 1-14 under 35 U.S.C. § 103(a), as being unpatentable over the Nosaki patent, be reconsidered and withdrawn.

Claim 15

The rejection of claim 15 under 35 U.S.C. § 103(a), as being unpatentable over the Nosaki patent and further in view of the Masato publication, is respectfully traversed based on the following.

According to claim 15 a facsimile requires a confirmation apparatus adapted to confirm receipt of notification by a source and a deleting apparatus adapted to delete stored confidential image data wherein a notification transmitter transmits the notification after a predetermined time if the confidential image data has not been retrieved and the deleting apparatus deletes the confidential image data when the confirmation apparatus confirms that the source has received the notification.

The indication in the Office Action, that the Nosaki patent does not disclose that a deletion apparatus that is adapted to delete confidential image data when a confirmation apparatus confirms that a source has received the notification, is acknowledged with appreciation. However, contrary to the statement in the Office Action, the Nosaki patent does not disclose a confirmation apparatus as required by claim 15. In particular, the Office Action states that column 8, lines 22-26, of the Nosaki patent discloses a confirmation apparatus adapted to confirm receipt of notification by a source; however, column 8, lines 22-26 of the Nosaki patent, describes that a check is performed to verify whether all data being sent from file server 3 to a designated printer has been sent. The designated printer that receives the data, however, is not a source of the confidential image data, as required by claim 15. Thus, the Nosaki patent does not disclose or suggest any device which confirms that notification transmitted to the source is received by the source, and further, does not

disclose or suggest a deleting apparatus that deletes confidential image data when the confirmation apparatus confirms that a source has received notification.

Similarly, the Masato publication also does not disclose or suggest a confirmation apparatus as required by claim 15, and does not disclose or suggest a deleting apparatus that deletes confidential image data when the confirmation apparatus confirms that the source of the confidential image data has received the notification. According to the Abstract of the Masato publication, an instruction control means permits deletion of picture data when an input means performs a prescribed input. However, the Masato publication does not disclose or suggest deleting image data when it has been confirmed that a source of the image data has received a notification. In fact, according to the Masato publication, deletion is performed based on whether or not a prescribed input is correct, not when it is confirmed that a source of the image data has received a notification. Thus, the Masato publication does not teach or suggest a device which deletes confidential image data when it is confirmed that a source has received notification, as required by claim 15.

Therefore, as both the Nosaki patent and the Masato publication do not disclose or suggest a device having a confirmation apparatus that deletes confidential image data when a confirmation apparatus confirms that a source of the confidential image data has received the notification, there is no combination of the Nosaki patent and the Masato publication that can render claim 15 obvious.

Accordingly, it is respectfully requested that the rejection of claim 15 under 35 U.S.C. § 103(a), as being unpatentable over the Nosaki patent and further in view of the Masato publication, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

Serial No. 09/108,715

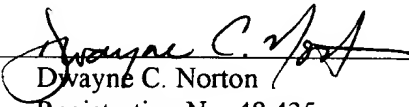
This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood's Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

By:


Dwayne C. Norton
Registration No. 48,435
Agent for Applicant

DCN:jkk:bar
SIDLEY AUSTIN BROWN & WOOD
717 N. Harwood, Suite 3400
Dallas, Texas 75201
Direct: (214) 981-3328
Main: (214) 981-3300
Facsimile: (214) 981-3400
December 18, 2001



APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

The following is a marked-up version of the changes to the claims which are being made in the attached response to the Office Action dated August 22, 2001.

IN THE SPECIFICATION:

Paragraph beginning at page 4, line 1, and ending at page 4, line 18:

According to another aspect of the present invention, [A] a facsimile apparatus provided with a confidential reception function[, the facsimile apparatus] comprises: a memory which stores received confidential image data; an output means which outputs the stored confidential image data in response to input of a password by an operator; a determination means which determines whether or not the confidential image data has been output by the output means within a predetermined time after its reception; a notification data transmission means which transmits notification data indicating that confidential image data has not been output, in the event that the determination means has determined that output of the confidential image data has not been performed; a detection means which detects proper completion of transmission of the notification data; and a deletion means which deletes the confidential image data from the memory in response to detection by the detection means.

Paragraph beginning at page 4, line 19, and ending at page 5, line 8:

According to another aspect of the present invention, a managing method for a confidential received image in a facsimile apparatus provided with a confidential reception function[, the managing method] comprises the steps of: receiving confidential image

Serial No. 09/108,715

data and storing the image data in a memory; monitoring whether the stored confidential image data has been output within a predetermined time after the reception; transmitting notification data indicating that output has not occurred, in the event that output has not occurred within the predetermined time; detecting proper completion of transmission of the notification data; and deleting the confidential image data from the memory in response to the detection.

Paragraph beginning at page 5, line 9, and ending at page 5, line 20:

Thus, when confidential received image data is not retrieved from memory even when a fixed interval has passed, data providing notification that said image data has not been retrieved is transmitted to the (original) sender, and said image data is deleted from a memory upon completion of proper transmission of this notification data. Because image data deletion is carried out when transmission of notification data to the sender is complete, even if confidential image data is deleted by the receiver, the sender is aware that [said] the confidential image data was not received, and appropriate measures can be taken.

Paragraph beginning at page 10, line 9, and ending at page 11, line 7:

Memory 10 includes transmission data area E1, reception data area E2, and control data area E3. Transmission data area E1 stores multiple sets of confidential transmitted transmission image data DS in a manner corresponding to transmission partner passwords PSS which specify a transmission partner. Reception data area E2 provides multiple mailboxes 101 which store received data, and in each mailbox 101 is stored mailbox name MN, and password PSD which specifies [said] the mailbox and provides access permission. Confidential received image data DR addressed to a said mailbox 101 is stored in a manner corresponding to its time of receipt TR and its transmitter

telephone number TE. Control data area E3 stores control data which notifies a sender that confidential received image data has not been retrieved when such an instance occurs. In other words, control data area E3 stores dial iteration data N which designates a maximum number of redials to be performed until the sender receives said notification, and fixed interval data T which indicates the elapsed time from the arrival of the image data and serves as a basis for assessing whether or not to notify the sender that said image data has not been retrieved.

Paragraph beginning at page 20, line 19, and ending at page 20, line 24:

Part of the notification data also includes confidential received image data DR that was not retrieved, which allows the sender to ascertain reliably what said image data is in specific terms, and which also allows the sender to retransmit [said] the image data or to take other appropriate action quickly.

IN THE CLAIMS:

1. (Three Times Amended) A facsimile apparatus which is capable of receiving confidential image data from an origin and which is provided with a confidential reception function, comprising:

a memory which stores received confidential image data;

a notification data transmission means for transmitting notification, [data] to said origin, [origin] indicating that the received confidential image data has not been retrieved from said memory; and

a deletion means for deleting the confidential image data from the memory in response to a completion of transmission of said notification [data] by the notification data transmission means;

wherein said notification [data] is transmitted if the received confidential image data has not been retrieved from the memory within a predetermined period of time.

2. (Once Amended) A facsimile apparatus as claimed in claim 1, wherein said notification [data] includes at least part of the confidential image data.

3. (Twice Amended) A facsimile apparatus as claimed in claim 1, wherein said notification [data] includes time information of the confidential image data transmission.

4. (Twice Amended) A facsimile apparatus as claimed in claim 1, wherein said notification [data] includes addressee information of the confidential image data.

5. (Twice Amended) A facsimile apparatus as claimed in claim 1, wherein said notification [data] includes information providing notification that the confidential image data was erased.

6. (Three Times Amended) A facsimile apparatus as claimed in claim 1, wherein said notification data transmission means re-transmits the notification [data] when transmission of the notification [data] is not completed successfully.

7. (Three Times Amended) A facsimile apparatus as claimed in claim 6, further comprising:

a prohibiting means for prohibiting the deletion of the confidential image data when the transmission of the notification [data] is not completed within a predetermined number of retransmission attempts.

9. (Twice Amended) A facsimile apparatus as claimed in claim 8, wherein said notification data transmission means transmits the notification [data] using the identified telephone number.

11. (Three Times Amended) A facsimile apparatus provided with a confidential reception function, comprising:

a memory which stores received confidential image data;

an output means for outputting stored confidential image data from said memory in response to input of a password by an operator;

a determination means for determining whether confidential image data has been outputted by the output means within a predetermined time after reception of the confidential image data;

a notification data transmission means for transmitting notification [data], indicating that confidential image data has not been outputted from the memory, when the determination means has determined that outputting of the confidential image data from the memory has not been performed;

a detection means for detecting proper completion of transmission of the notification [data]; and

a deletion means for deleting confidential image data from the memory in response to detection of proper completion of transmission of the [transmission data] notification by the detection means.

12. (Once Amended) A facsimile apparatus as claimed in claim 11, wherein said notification [data] includes at least a part of the confidential image data.

13. (Three Times Amended) A managing method for managing a confidential received image in a facsimile apparatus, the facsimile apparatus being provided with a confidential reception function, the method comprising the steps of:

receiving confidential image data and storing the received image data in a memory in the facsimile apparatus;

monitoring whether the stored confidential image data has been outputted within a predetermined time after reception of the confidential image data;

transmitting notification [data], indicating that output has not occurred, when outputting of the confidential image data has not occurred within the predetermined time;

detecting proper completion of transmission of the notification [data]; and

deleting the confidential image data from the memory in response to a detection of the proper completion of transmission of the notification [data].

14. (Once Amended) A managing method as claimed in claim 13, wherein said notification [data] includes at least part of the confidential image data.

15. (Twice Amended) A facsimile apparatus capable of receiving confidential image data from a source, the facsimile apparatus comprising:
a memory capable of storing received confidential image data;
a notification transmitter adapted to transmit a notification [data] to the source;
a confirmation apparatus adapted to confirm receipt of the notification [data] by the source; and
a deleting apparatus adapted to delete stored confidential image data, wherein the notification transmitter transmits the notification [data] after a predetermined time if the confidential image data has not been retrieved, and the deleting apparatus deletes the confidential image data when the confirmation apparatus confirms that the source has received the notification [data].